

REMARKS

Prosecution History

The applicants filed an appeal brief on 6/29/05, and the examiner filed an answer brief including a new grounds for rejection. Accordingly, the applicants file this request to reopen prosecution in order to address the new grounds for rejection.

The applicants also asserted an argument in the opening brief with respect to Fletcher et al. (6,138,156) that was not addressed by the examiner. The applicants argued that data requested by a user is not information that is transmitted to a mobile terminal using synchronization rules. The examiner failed to address this argument in the answer brief, and instead focused on whether Fletcher “orders” data transmitted to a mobile terminal. Regardless of whether or not Fletcher teaches to “order” data, data requested by a user is not transmitted using synchronization rules. The applicants do not believe the application is in condition for appeal until the examiner fully addresses this argument.

Claim Rejections - 35 USC §102

The examiner rejected claims 1, 7, 11, 31, 37 and 41 under 35 USC §102(e) as anticipated by Fletcher et al. (6,138,156). The applicants respectfully disagree.

Regarding claims 1 and 31, the examiner asserts that Fletcher discloses the ordering limitation because the most frequently requested messages are transmitted to the mobile terminal first, and “information that is only occasionally requested will have to be requested for by the user thereafter.” (Emphasis added.) This argument is misplaced because information requested by the user is not information that is transmitted to the terminal using the synchronization rules.

On page 5, second paragraph, of the final office action, the examiner asserted that a user, or a system administrator, submits rules to a filter engine 400. These rules control the exchange of synchronization data between the mobile terminal and the target

computer (col. 10, lines 28-38). Although this interpretation of Fletcher is correct, the rules submitted to the filter engine 400 are not used to transmit data requested by the user. If a user requests data from the target computer, the target computer transmits the data to the mobile terminal independent of the synchronization rules. Because the examiner is relying on data requested by the user as “ordered data,” the rejection should be withdrawn since user requested data is not transferred to the mobile terminal using the synchronization rules as recited in the claims.

The rejections of the remaining claims should be withdrawn for at least the reasons set forth above.

Claim Rejections - 35 USC §103

The examiner rejected claims 2, 4, 6, 12-15, 17, 19, 21, 27-30, 32, 34, 36 and 42-45 under 35 USC §103(a) as unpatentable over Fletcher in view of Kalish et al. (2002/0116472). The applicants believe these rejections should be withdrawn for the reasons set forth above.

The examiner rejected claims 3, 5, 9, 10, 16, 18, 20, 22-26, 33, 35, 39 and 40 under 35 USC §103(a) as unpatentable over Fletcher. The applicants respectfully disagree.

Regarding claims 3, 18, and 33, Fletcher does not disclose or suggest to transmit modified synchronization rules from a mobile terminal to a target computer. Fletcher does not observe or modify the synchronization rules at the mobile terminal, rather Fletcher discloses to modify the synchronization rules at a server (target computer). Since the synchronization rules are modified at the server, there is no need to transmit modified synchronization rules to the server.

In the answer brief, the examiner agreed with this argument, but asserted it would have been obvious to modify Fletcher to transmit modified synchronization rules from a mobile terminal to a target computer because “it would have advantageously allowed for the rules to be stored in the target computer, thereby freeing valuable storage resources at the mobile terminal.” Not only does the prior art fail to suggest this motivation to modify Fletcher, the examiner’s stated motivation is not technologically sound. One skilled in the art would not be concerned with saving a few hundred bytes of memory at the mobile terminal, when the typical storage capacity exceeds megabytes, and in many cases gigabytes, in today’s mobile terminals.

Nothing in the prior art suggests modifying Fletcher to transmit modified synchronization rules from a mobile terminal to a target computer. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (In re Fritch 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).)

Regarding claims 9, 24 and 39, Fletcher does not disclose or suggest to transmit emails to a mobile terminal before transmitting web pages to the mobile terminal based on synchronization rules derived from monitoring a user’s preference in viewing the synchronization data.

In the answer brief, the examiner agreed with this argument, but asserted that Fletcher could be modified because it would “advantageously allow the user to view emails before viewing web pages.” Again, the examiner relies on no prior art reference to teach this modification to Fletcher. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (In re Fritch 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).)

Regarding claims 10, 25, and 40, Fletcher does not disclose or suggest to transmit first web pages to a mobile terminal before transmitting second web pages to the mobile terminal based on synchronization rules derived from monitoring a user's preference in viewing the synchronization data.

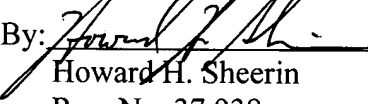
In the answer brief, the examiner agreed with this argument, but asserted that Fletcher could be modified because it would "advantageously allow the user to view a most frequently requested web page before a web page that was occasionally requested." Again, the examiner relies on no prior art reference to teach this modification to Fletcher. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (In re Fritch 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).)

The rejections of the remaining claims should be withdrawn for at least the reasons set forth above.

CONCLUSION

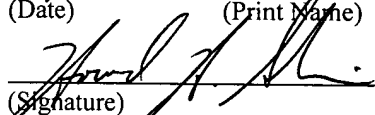
In view of the foregoing remarks, the rejections should be withdrawn. The examiner is encouraged to contact the undersigned over the telephone in order to resolve any remaining issues that may prevent the immediate allowance of the present application.

Respectfully submitted,

Date: 10/18/05 By: 
Howard H. Sheerin
Reg. No. 37,938
Tel. No. (303) 765-1689

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

10/18/05 Howard H. Sheerin
(Date) (Print Name)

(Signature)